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Dated: August 9, 2007 Electronic Signature of Thomas J. Scott, Jr.: /Thomas J. Scott, Jr./

Docket No.: PMC-003C201  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Patent Application of:  
John C. Harvey et al.

Appeal No.: 2007-2115

Application No.: 08/487,526

Confirmation No.: 7792

Filed: June 7, 1995

Art Unit: 2627

For: SIGNAL PROCESSING APPARATUS AND  
METHODS

Examiner: W. J. Klimowicz

**STATUS INQUIRY**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This application has been pending for over twelve years with an actual filing date of June 7, 1995, and has an effective pendency of more than nineteen years with an effective filing date of at least September 11, 1987.<sup>1</sup> This application is thus entitled to special status under the provisions of the MANUAL OF PATENT EXAMINING PROCEDURE §§ 707.02 and 708.01(I) (8<sup>th</sup> Ed., Rev. 5, 2006). There have been repeated delays in the prosecution of this application that are inconsistent with the obligation of the Patent and Trademark Office ("Office") to advance this application out of turn for accelerated examination as required for a "special" application. Appellants request that the clerk of the Board of Patent Appeals and Interferences ("Board") inform appellants when a Notification of Appeal Hearing is expected to be issued.

The delay in hearing this appeal would be troublesome for any applicant. Appellants, moreover, are acutely sensitive to unreasonable delay in this appeal. This sensitivity arises not in the least because the Office refuses to conduct further examination in fifty-four related applications pending the outcome of this appeal and the outcome of related Appeal Proceeding

<sup>1</sup> Appellants further claim priority to a parent application filed on November 3, 1981. However, the Examiner has, in appellants' view improperly, challenged this priority claim.

2007-1837 regarding related application Serial No. 08/470,571. The Office argues that the outcome of these two appeal proceedings will “have a profound effect on the prosecution” of all of appellants’ copending related applications. *See e.g.* Decision on Petition mailed Nov. 27, 2006 in App. Ser. No. 08/487,410 at p. 4. The Office has repeatedly justified suspending action in appellants’ copending applications pending the outcome of these two pending appeals. With the exception of these two applications under appeal, no substantive action has been issued by the Office in any of appellants’ related pending applications for almost four years. As these related applications all have been pending for over twelve years, appellants request that these two pending appeal proceedings, upon which the Office has conditioned further prosecution of all of appellants’ related applications, proceed without further delay.

This appeal has not proceeded without delay. The Notice of Appeal was filed on October 7, 2004. The Appeal Brief was filed over 29 months ago, on March 7, 2005. After waiting for nearly five months for the Examiner to answer the Appeal Brief, appellants felt compelled to file a Petition to the Director Under 37 U.S.C. § 1.181 to request that the Director exercise his supervisory authority to compel the Examiner to issue an Answer. The petition was filed August 4, 2005. The Director of Technology Center 2600 acted on the petition on September 6, 2005. The TC Director directed the Examiner to take this application up for action and to treat this application as special under in accordance with M.P.E.P. § 708.01. Nearly another five months passed before the Examiner issued a Examiner’s Answer on January 31, 2006. Appellants filed a Reply Brief on March 27, 2006. On June 23, 2006, nearly three months later, the Examiner noted the Reply Brief and forwarded the application to the Board.<sup>2</sup> Nearly four months later, on October 19, 2006, the Board issued an Order Returning Undocked Appeal to Examiner. The Order noted that the Examiner had not indicated that each Information

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<sup>2</sup> Appellants did file on May 2, 2006, a Request to Amend Appeal Brief Under 37 C.F.R. § 41.37(d). On April 11, 2006, appellants received a Order Returning Undocketed Appeal to Examiner in related copending application 08/470,571 (now Appeal No. 2007-1837). The ‘571 Order noted that the appeal was defective as the Examiner had not indicated that each of the Information Disclosure Statements (IDSs) had been considered. The ‘571 Order further noted that the Appeal Brief was missing the “Summary of the Claimed Subject Matter” as required by 37 C.F.R. § 41.37(c)(1)(v) although the ‘571 Appeal Brief included the required material in the proper order under the heading “Summary Of The Invention.” In light of the ‘571 Order, appellants reviewed this appeal and noted that similar to the ‘571 Appeal, the Examiner had not indicated that each IDS had been considered and the Appeal Brief used the incorrect heading. Appellants contacted the Examiner regarding these issues. It was agreed that the Examiner would accept a request to amend the Appeal Brief to correct the heading. Appellants further urged the Examiner to ensure that each IDS of record be properly considered prior to transferring jurisdiction of this appeal to the Board.

Disclosure Statement had been considered.<sup>3</sup> The Examiner mailed copies of the Examiner considered Information Disclosure Statements on October 3, 2006. However, the Board still did not take up this appeal.

In March 2007, Appellants' representatives held a series of telephone conversations with Deborah Vega at the Board.<sup>4</sup> Ms. Vega noted that the application file provided to the Board was missing several references relied upon by the Examiner as the basis of several rejections under appeal. Ms. Vega inquired as to whether appellants would provide the missing references from their files. Appellants provided Ms. Vega with copies of the references in their possession. However, two references requested by Ms. Vega had not been of record in the prosecution of this application. Ms. Vega requested English translations of Japanese Patent Application Publications 25-22423 and 56-8975. Appellants were unaware of any translations of these Japanese documents. In fact, appellants had repeatedly noted that the absence of translations of these documents was an error in the Examiner's rejections.<sup>5</sup> Ms. Vega acknowledged that it was the Examiner's duty to obtain English translations of documents relied upon as the basis of claim rejections. However, Ms. Vega stated this appeal would not be docketed without the required English translations. Ms. Vega asserted that if appellants could not provide the English translations, the application would be returned to the Examiner to comply with the requirements of M.P.E.P. §. 706.02.

As noted above, prosecution in fifty-four of appellants' copending applications remains suspended pending the outcome of this appeal. In particular, the Examiner has taken the position that appellants are barred from claiming priority to parent application 06/317,510 in any of appellants' copending applications.<sup>6</sup> This issue is ripe for resolution in this appeal.<sup>7</sup> Appellants, however, were placed in the untenable position of being required to perform the

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<sup>3</sup> This delay occurred despite Appellants' entreaty to the Examiner that this issue be resolved prior to transfer of the Appeal to the Board.

<sup>4</sup> The telephone conversations initially addressed Application 08/470,571 (now Appeal No. 2007-1873). When appellants inquired about this application, Ms. Vega was initially unable to confirm that jurisdiction had been transferred to the Board. After locating this application, Ms. Vega determined that issues similar to those in the '571 application required resolution prior to assignment of an appeal number.

<sup>5</sup> See Response To Final Office Action filed Oct. 7, 2004, pp. 39 & 41; Appeal Brief, pp. 47-48 & 50; Reply Brief, p. 8.

<sup>6</sup> The Office has suspended prosecution in all of Appellants' copending application, except Application 08/470,571, despite the fact that the priority claim is not an issue in many of these applications.

<sup>7</sup> The priority claim is no longer at issue in copending Appeal No. 2007-1873 (Application 08/470,571) as the Examiner has withdrawn all rejections based upon alleged intervening prior art.

Examiner's duty of providing the required English translations or suffer further delay in this critical appeal. Appellants elected to have translations performed at their own expense and to provide the translations to the Board in order to minimize further delay. Appellants provided the translated documents to Ms. Vega on April 9, 2006. This appeal was assigned docket no. 2007-2115 on April 24, 2007. Now over three months later appellants have yet to receive a Notification of Appeal Hearing.

Appellants have reviewed the July 2007 Board of Patent Appeals and Interferences Public Hearing Schedule and determined the following.<sup>8</sup> The median time period between mailing a Docketing Notice and mailing a Notification of Appeal Hearing in the appeals scheduled to be heard in July is one month and seventeen days. In all but two of the appeals, the Notification of Appeal Hearing was mailed within three months and three days of mailing the Docketing Notice. Appellants are greatly concerned that in the proceedings in which the Notification of Appeal Hearing was not mailed within three months and three days the Notification was delayed for a much greater time. The Notification of Appeal Hearing was not mailed in over five months in Appeal Proceeding 2007-0318 and was not mailed in over seven months in Appeal Proceeding 2006-3366.

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<sup>8</sup> The July 2007 Public Hearing Schedule lists Proceeding No. 2007-1664 as corresponding to Application Serial No. 09/868,040. This application is not accessible through the Public Application Information Retrieval system and is thus not included in the statistics presented herein.

Appellants request that the Board confirm that this appeal proceeding is being treated as a special case in accord with the Decision on Petition mailed September 6, 2005. Appellants further request that this appeal proceeding be assigned a hearing date before hearing dates are assigned in any further non-special proceedings in which a Docketing Notice was mailed after April 24, 2007. Should there be any reason that the Board is delaying mailing of the Notification of Appeal Hearing in this proceeding, appellants request an explanation of the reasons for delay and request to be given all reasonable opportunities to mitigate any cause of the delay.

Dated: August 9, 2007

Respectfully submitted,

By /Thomas J. Scott, Jr./

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